

REMARKS

The Applicant has filed the present Response pursuant to 37 C.F.R. §1.111 in reply to the outstanding Official Action of December 9, 2002, and the Applicant believes the Response to be fully responsive to the Official Action for reasons set forth below in greater detail.

In the present Official Action, the Examiner rejected Claims 1-10 pursuant to 35 U.S.C. 103(a), as allegedly unpatentable over Abe Yuko (Japanese Patent Application No. 8-275216) (hereinafter "Yuko"), which was cited in an Information Disclosure Statement for the above-identified U.S. patent application. More specifically, the Examiner alleged that Yuko's automatic stop means and the release of the automatic stop means for emergent messages teaches or suggests the combination of automatically stopping sound generation and switching to another alert operation, and continuous sound generation, as particularly claimed in Claims 1 and 10.

The Applicant respectfully disagrees with the Examiner's allegations and as a consequence proffers the following arguments to patentably distinguish the claimed invention from the primary prior art reference to Yuko pursuant to 35 U.S.C. §103(a).

Insofar as rejections pursuant to 35 U.S.C. §103(a) are concerned, the Federal Circuit in In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) has annunciated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification" (emphasis added). Furthermore, the annunciated principle requires that the prior art suggest modifying the teachings of the references so as to produce the claimed invention. Id. At the time the invention is made, there must be

reason apparent to a skilled artisan for applying the teachings of the reference or else the use of such teachings will be improper hindsight. In re Noyima, 184 USPQ 607 (C.C.P.A. 1975). Additionally, the Examiner cannot establish obviousness by locating references which describe various aspects of an invention without also providing evidence of the motivating force which would impel the skilled artisan to do what the applicant has done. Ex Parte Levengood, 28 USPQ 2d 1330, 1302 (Bd. Pt. App. & Int'f. 1993).

The primary prior art reference to Yuko is directed to a pocket beeper 1 having a kidnapping prevention function. Specifically, Yuko teaches an automatic stop means for stopping the generation of an alarm tone automatically for the "non-emergent" messages received by the pocket beeper 1. The kinds of alarm tones correspond to predetermined messages. Additionally, Yuko teaches releasing the automatic stop means for continuously generating an emergent alarm tone and displaying an emergent mark on display means 2 for the "emergent" messages received by the pocket beeper 1.

In traversing the rejections of Claims 1 and 10 pursuant 35 U.S.C. 103(a), the Applicant respectfully submits that primary prior art reference to Yuko is defective in that it fails to teach or suggest the selective call receiver as claimed. More specifically and contrary to the Examiner's allegations, Yuko does not teach or suggest automatically stopping sound generation and switching to another alert operation (i.e., Table 1 illustrated in Figure 7A), as particularly recited in Claims 1 and 10. That is, although Yuko teaches stopping the generation of its alarm tone for the "non-emergent" messages received by the pocket beeper 1, Yuko does not teach or suggest switching to another alert operation after sound generation is automatically stopped. Consequently, the

Applicant respectfully submits that this patentably distinguishes the claimed invention from Yuko.

In view of the foregoing, the Applicant respectfully requests the Examiner to withdraw the rejections of independent Claims 1 and 10 pursuant to 35 U.S.C. §103(a). The Applicant further respectfully requests the examiner to withdraw the rejections of Claims 2-9 based on their respective dependencies, whether direct or indirect, from independent Claim 1.

In addition to the arguments presented hereinabove regarding the independent Claims 1 and 10, the Applicant further respectfully submits that Claim 5, independently from Claim 1, distinguishes the present invention from Yuko. More specifically, Claim 5 recites an instruction for a type of sound set for continuous sound generation on the basis of current consumption. It is a characteristic feature of the present invention to alert with a beep sound having dedicated (i.e., special) pattern at the time of performing continuous sound generation. Via this feature, it becomes possible to reduce current consumption for the continuous sound generation, because the dedicated pattern of beep sound is set to have the least current consumption. This feature is clearly depicted in Figs. 8 and 9 and can be easily understood from the figures in view of the page 17, lines 1-24, of the above-identified application. Although the Examiner alleged that Claim 5 is merely a design choice, the Applicant in contradiction respectfully submits that Yuko does not teach or suggest an alert having continuous sound generation with a type of sound for the continuous sound generation set on the basis of current consumption. Yuko is completely silent in addressing this characteristic feature of the present invention.

In view of the foregoing, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the allowance of the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, the Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



Paul J. Esatto, Jr.
Reg. No. 30,749

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
PJE/AGV:eg